



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,075	11/25/2003	Yukiko Yoshida	1081.1184	4909
21171 7590 02/05/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER CASLER, TRACI	
			ART UNIT 3629	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/05/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/720,075

Applicant(s)

YOSHIDA, YUKIKO

Examiner

Traci L. Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to papers filed on August 31, 2006.

Claims 1 and 9-12 have been amended.

Claims 1-12 are pending.

Claims 1-12 are rejected.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 31, 2006 has been entered.

Specification

2. The amendment filed August 31, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Being independent of any particular user".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3629

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has added the limitation of "being independent of any particular user". However, applicants invention as originally disclosed does not support this limitation. This limitation puts the claims in a narrower scope than the specification allows. Applicant discloses **examples** of environmental conditions as being taxation issues and telephone charges, both of these limitations would have to be related to the geographic region of the user, therefore can not be interpreted as "independent" of any particular user. These conditions as disclosed by applicant would have to be considered specific to the users location therefore specific to the user themselves. Applicant merely states the conditions are NOT SET by the user.

1. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicants claims state "customizing values" which are used to develop and/or determine how the information is "customized" for the user. . . . As for the limitation of "customizing and/or changing values" the specification fails to identify how

the values are changed/customized using the conditions. What about the values is changing? If it's the user values how can the apparatus change them? How are these values determined?

5. Furthermore, in claim 12 applicant claims the limitation of "problem-solving process". Although applicant discloses a "problem-solving process" in the disclosure applicant fails to identify what this process is and how it is applied. Therefore, the disclosure fails to enable one of ordinary skill in the art at the time of invention to make and or use applicants invention to obtain reproducible results and without undue experimentation.

Claim Rejections - 35 USC § 103

6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,052,714 Miike et al; Information Filtering Apparatus and Method for Retrieving a Selected Article From Information Sources, hereinafter called Miike; in view of US Patent 6138142 Linsk; Method for providing customized web information based on attributes of the requester.

2. As to claims 1 and 9-12 An information providing apparatus and method that provides

information to a terminal of user through a network,

comprising:

-storage unit for storing environmental conditions that are predetermined conditions for an event relating information provided by predetermined

information provider; Miike teaches an apparatus with a storage unit of predetermined conditions.(C.3 I. 32-36)

-a control unit for acquiring user conditions that are inputted by the user and that are the conditions relating and specific to the user, from the terminal of the user through the network; Miike teaches an apparatus with a unit for receiving conditions(C. 3 I. 48-49)

-a structuring unit for structuring, in conformity with the environmental conditions, detailed information that is the information corresponding the user conditions relating for the event, *including customizing values of the information*(**Miike teaches ranking items according to the value determined by similarity C. 4 I. 5-6, 10-12**) Miike teaches an apparatus with a unit for querying information (C. 3 I. 62-63)

3. -the control unit distributes the detailed information to the terminal. Miike teaches an apparatus with a unit that distributes the information(C. 4 I. 7-9)

4. However, Miike fails to teach conditions being independent(not set) by users). Linsk teaches conditions determined by the system that are based on the users geographic location(C. 3 I. 20-25). It would have been obvious to one of ordinary skill in the art at the time of invention to combine Linsk with Miike as requirements for laws governing the users location need to be followed.

5. As to claim 2 Miike teaches an apparatus with a storing unit and a unit to perform query(C. 4 . 7-12)

and allows user to alter extracted information(C. 7 I. 57-60).

Art Unit: 3629

6. As to claims 3 and 4 Miike teaches an apparatus with a unit executing a program in response to conditions(C. 3 I. 47-49)
7. As to claim 5 Miike teaches an apparatus with a unit that can create a value to determine information(C. 4 I. 1-4)
8. As to claim 6 Miike teaches an apparatus with changing conditions and recreating detailed information that is distributed to the user(C. 7 I. 65-67; C. 8 I. 1-2).
9. As to claim 7 Miike teaches an apparatus providing a news article as the information(c. 3 I. 2-4).
10. As to claim 8 Miike teaches an apparatus linked via a network(c. 3 I. 10-11)

Response to Arguments

11. Applicant's arguments filed August 31, 2006 have been fully considered but they are not persuasive.
12. As to applicants arguments regarding the enablement issues, applicant believes the present amendments correct these deficiencies. However, as stated above the examiner maintains that applicants disclosure does not enable one of ordinary skill in the art at the time of invention to make and/or use the invention to obtain identical(reproducible) results without undue experimentation.
13. As to applicants arguments of the rejections under 35 USC 102 regarding the limitation of "independent of any particular user". These arguments are moot in view of the new rejections and these newly amended limitations have been address in rejections stated above.

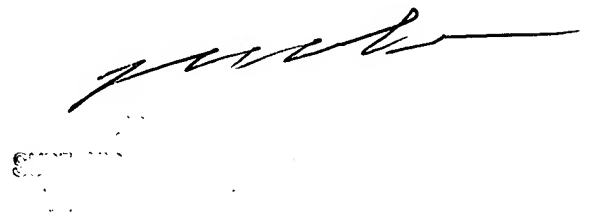
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC

A handwritten signature in black ink, appearing to be "TLC", is located at the bottom right of the page.